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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/661,164

09/13/2000

Dan Kikinis

004688.P021

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05/21/2004

ROBERT J. DEPKE LEWIS T. STEADMAN  
HOLLAND & KNIGHT LLC  
131 SOUTH DEARBORN  
30TH FLOOR  
CHICAGO, IL 60603

EXAMINER

TRAN, HAI V

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/661,164

**Applicant(s)**

KIKINIS DAN

**Examiner**

Hai Tran

**Art Unit**

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-10</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-5, 10-15, 20-24, 26-30 are rejected under 35 U.S.C. 102(b) as being unpatentable by Hite et al. (US 5774170).

Claim 1, Hite discloses a system comprising:

A receiver (Fig. 1, el. 400 and Fig. 5) to receive a broadcast stream and recorded media; and

A unit (Commercial processor 438) to compare a priority indicator (CID code) in the broadcast stream (the broadcast with a code containing in the break) and a priority indicator (CID code stored in the storage Ad Queue) in the recorded media, the unit permitting insertion of the recorded media into the broadcast stream when the priority indicators in the recorded media are higher than in the broadcast stream and delaying insertion when the priority indicators in the recorded media are lower than in the broadcast stream (Col. 6, lines 60 - Col. 7, lines 51).

Claim 2, Hite further discloses wherein the priority indicators are numbers, letters or symbols in the broadcast stream and in the recorded media is further met

by Hite in which the CID code must be coded by numbers, letters or symbols according to the provider's operator.

Claim 3, Hite further discloses "wherein the recorded media and the broadcast stream are the same media" reads on transmitted on the same transmission carrier (Col. 5, lines 51-62).

Claim 4, Hite further discloses "wherein the recorded media and the broadcast stream are different media" reads on transmitted on different transmission carrier (Col. 5, lines 51-62).

Claim 5, Hite further discloses "wherein an event triggers the recorded media insertion into the broadcast stream" reads on by detecting of the CDI code embedded within the broadcast stream and comparing the embedded CDI code and the CID previously store. If there is a match, the recorded media (commercial) is inserted into the received broadcast stream and displayed (Col. 6, lines 27-35).

Claim 10, Hite further discloses wherein the receiver is part of a television system or radio system (see Fig. 5).

Claim 11, Hite discloses a method of inserting recorded media into a broadcast stream, the method comprising:

Transmitting a broadcast stream and recorded media to a receiver of a broadcast system, the broadcast stream and the recorded media containing one or more priority indicators (Col. 5, lines 40-Col. 7, lines 51); and

Comparing priority indicators (incoming CID code) in the broadcast stream with priority indicators (CID code stored in the storage Ad Queue) in the recorded media (Col. 7, lines 24-31); and

Inserting the recorded media into the broadcast stream when the priority indicators in the recorded media are higher than in the broadcast stream (substitute the default Ad with the addressed Ad) and delaying inserting (do not substitute the default Ad) when the recorded media into the broadcast stream when the priority indicators in the recorded media are lower than in the broadcast stream (Col. 6, lines 60 - Col. 7, lines 51).

Claim 12 is analyzed with respect to claim 2.

Claim 13 is analyzed with respect to claim 3.

Claim 14 is analyzed with respect to claim 4.

Claim 15 is analyzed with respect to claim 5.

Claim 20 a system (Fig. 1) comprising:

A server (Fig. 2);

A set top box (Fig. 5) coupled to a server;

A receiver 410 in the STB (Fig. 5) to receive a broadcast stream and recorded media;

A transmitter 444 in the receiver (Fig. 5) to transmit the broadcast stream and the recorded media to a TV receiver 450; and

A unit (commercial processor 438 in the STB to compare one or more priority indicators (incoming CID code) in the broadcast stream and in the recorded media (Col. 7, lines 24-31), the unit permitting insertion of the recorded media into the broadcast stream when the priority indicators in the recorded media are higher than in the broadcast stream (substitute the default Ad with the addressed Ad) and delaying insertion when the priority indicators in the recorded media are lower than in the broadcast stream (Col. 6, lines 60 - Col. 7, lines 51).

Claim 21 is analyzed with respect to claim 2.

Claim 22 is analyzed with respect to claim 3.

Claim 23 is analyzed with respect to claim 4.

Claim 24 is analyzed with respect to claim 5.

Claim 26, is further analyzed with respect to claim 1 in which "a machine readable storage medium tangibly embodying a sequence of instructions executable by the machine to perform a method for inserting recorded media into a broadcast stream" is inherently met by Hite' system because Hite 's system must have at least memory/storage media, i.e., RAM and hard drive, that has software to perform the function as described.

Claim 27 is analyzed with respect to claim 2.

Claim 28 is analyzed with respect to claim 3.

Claim 29 is analyzed with respect to claim 4.

Claim 30 is analyzed with respect to claim 5.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6, 16, 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al. (US 5774170) in view of Handelman (US 5414773).

Claim 6, Hite does not disclose the event includes notification that an e-mail message has arrived.

Handelman discloses the event includes notification that an e-mail message has arrived (Col. 10, lines 13-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Hite with Handelman** so to notify user of new incoming mail while viewing the television program.

Claim 16 is analyzed with respect to claim 6.

Claim 25 is analyzed with respect to claim 6.

Claim 31 is analyzed with respect to claim 6.

3. Claims 7, 19 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al. (US 5774170) in view of Thurlow et al. (US 5796394).

Claim 7, "wherein a signal is programmed by a time mark, the time mark synchronizing the recorded media insertion with the broadcast stream" reads on the time-stamp embedded within the broadcast data stream in which video processor unit 444 uses the time-stamp information provided with the broadcasted data stream, in a conventional manner, for synchronizing the MPEG output of video/audio with the recorded media (commercial) so to display as disclosed.

Hite does not disclose a signal that is needed to change the priority indicator of the media insertion.

Thurlow discloses a signal that is needed to change the priority indicator of the media insertion (Fig. 6-9; Col. 9, lines 15-Col. 15, lines 65+); Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite with Thurlow so to allow user to create/edit rule for selectively inserting recorded media/text/message into the broadcast stream for displaying to the user.

Claim 19 is analyzed with respect to claim 7.

Claim 35 is analyzed with respect to claim 7.

4. Claims 8-9, 17-18, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al. (US 5774170) in view of Bullock et al. (US 5070404).

Claim 8, Hite does not disclose using a pilot tone or watermark as priority indicators.



Bullock discloses the use of cue code wherein each cue code comprises four DTMF tones as Indicator (Col. 6, lines 43-Col. 7, lines 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite with Bullock so to take the advantage of the uniqueness of each cue code for determining the presence of the stored data having an identifier corresponding to the cue signal and for providing an indication to the user of the presence of the stored data (Col. 2, lines 1-6).

Claim 9, Hite does not clearly disclose wherein the priority indicators are assigned to the recorded media insertions by a user of the system.

Bullock further discloses the priority indicators are assigned to the recorded media insertions by a user of the system (Col. 4, lines 38-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite with Bullock so to have an operator to assign the priority indicators to the recorded media insertions when it is needed.

Claim 17, "the priority indicators are embedded into the broadcast stream using a pilot tone or watermark" is analyzed with respect to claim 8 and Bullock further discloses wherein the broadcaster may assign a plurality of priority indicators to different segments of a broadcast stream (Col. 6, lines 60-65+).

Claim 18, Hite does not clearly disclose wherein the broadcaster may assign a plurality of priority indicators to different segments of a broadcast stream based on a subdivision or geographic area.

Bullock discloses the broadcaster may assign a plurality of priority indicators to different segments of a broadcast stream based on a subdivision or geographic area (Col. 7, lines 65-Col. 8, lines 6), the plurality of priority indicators allowing broadcasters to sell advertising space for the particular subdivision or geographic area. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite with Bullock so to control the distribution of commercial according certain jurisdictions.

Claim 32, "the priority indicators are embedded into the broadcast stream using a pilot tone or watermark" is analyzed with respect to claim 8 and Bullock further discloses wherein the broadcaster may assign a plurality of priority indicators to different segments of a broadcast stream (Col. 6, lines 60-65+).

Claim 33 is analyzed with respect to claim 18.

Claim 34 is analyzed with respect to claim with claim 9.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bellamy (US 6209025) shows an integrated video system.

Hite et al. (US 6002393) shows a system and method for delivering targeted advertisements to consumers using direct commands.

Farmer (US 5822018) shows a method and apparatus for normalizing signal levels in a signal processing system.

Marsh et al. (US 5848397) shows a method and apparatus for scheduling the presentation of message to computer users.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is 703-308-7372. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT:ht  
05/13/2004

  
HAI TRAN  
PATENT EXAMINER